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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/771,380 | 02/05/2004 | Tokio Ooi | 118520 | 3333 |
| 25944 7590 11/25/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | | |
| EXAMINER | | | | |
| HENDRICKSON, STUART L | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1793 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/771,380

Applicant(s)

OOI ET AL.

Examiner

Stuart Hendrickson

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1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/5/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the boiling point being the same as naphthalene- note the subtle difference in the verbiage of the specification.

Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as obvious over Walker 3638399 taken with Hayden 5466645.

Walker teaches in col. 2 and 4 treating active carbon having a wide pore size distribution with naphthalene and like compounds until it is saturated. No differences are seen in the carbon or the effect of the treatment. Note also the cooling of ex. 5. Concerning claim 5, it is implied, however to the extent that it is not taught, it is an obvious expedient to avoid burn-off of the carbon. Walker does not explicitly teach cooling in inert gas, however Hayden does in a similar process. Using this cooling is an obvious expedient to avoid burning of the active carbon and thus preserving its pore structure, consistent with the Walker teachings.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as obvious over the Nakano article taken with Hayden.

Nakano teaches, especially on pgs. 2, 3, contacting molecular sieve carbon (ie, active carbon) with naphthalene and like compounds at 200C and heating in inert gas. Concerning claims 4

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and 5, they are implied, however to the extent not taught, are an obvious expedient to avoid burning the carbon.

Nakano does not explicitly teach cooling in inert gas, however Hayden does in a similar process. Using this cooling is an obvious expedient to avoid burning of the active carbon and thus preserving its pore structure.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger 5260047 in view of Meenan et al. 4685220.

Berger teaches, especially in col. 2 and 5, various embodiments of sorbing heavy carbon impurities with active carbon and heating, then cooling under inert gas. Meenan col. 2 establishes the boiling points. This does not explicitly recite the claimed verbiage in one embodiment and the temperatures of Berger defacto overlap the temperature range claimed. However the overlapping range renders the claims obvious- see In re Malagrari et al 182 USPQ 549 and choosing the claimed protocol is an obvious expedient of optimization- see in re Boesch 205 USPQ 215. The effect of claim 3 is deemed possessed since the steps are/can be the same. Claims 4 and 5 are met in that the exact sequence/mechanism is unknown and desorbing/decomposition/transporting may occur simultaneously. No differences are seen in this regard.

Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

/Stuart Hendrickson/
examiner Art Unit 1793